

REMARKS

Applicants thank the Examiner for his review of the previously submitted amendments.

In the Office Action dated April 30, 2004, the Examiner (i) objected to the disclosure for an informality in the amendment to the paragraph of column 1, lines 9-14, in that the word "Rongeurs" was not underlined; (ii) objected to the oath/declaration for allegedly failing to identify the citizenship as well as the residence of inventor Gernot Weber; (iii) rejected claims 1-8 as being based on a defective reissue declaration; (iv) rejected claim 8 as anticipated by, or in the alternative, obvious over *Falk* (US 4,994,024); and (v) indicated allowable subject matter as to claims 1-7.

Specification

Applicants have resubmitted the paragraph of the disclosure objected to, wherein the noted informality has now been corrected.

Reissue Declaration

With regard to the reissue declaration, Applicants submit herewith a substitute reissue declaration by the inventors, a consent of assignee, a statement under 37 CFR 3.73(b), and two Powers of Attorney for the reissue application. A new consent and statement under 37 CFR 3.73(b) are needed because the patent was transferred from KMedic, Inc. to Pilling Weck Incorporated prior to the filing of the reissue application. Applicants inadvertently did not notice this transfer until recently.

Correcting Error in Small Entity Status

Applicants inform the Office that Pilling Weck Incorporated is not qualified as a small entity for fee payment purposes. KMedic, Inc. was a small entity, but as discussed earlier, by the time the reissue application was filed, the actual owner should be Pilling Weck Incorporated. Thus, a small entity status was established in error but in good faith and the small entity fee was paid in error but in good faith when the reissue application was filed.

The fee deficiency is detailed below:

The particular fee involved: basic reissue filing fee

The small entity fee amount actually paid: \$345 at the time of the reissue filing

The actual deficiency owed for each fee previously paid in error: \$425 (\$770

\$345 at the time of the reissue filing)

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The total deficiency owed: \$425

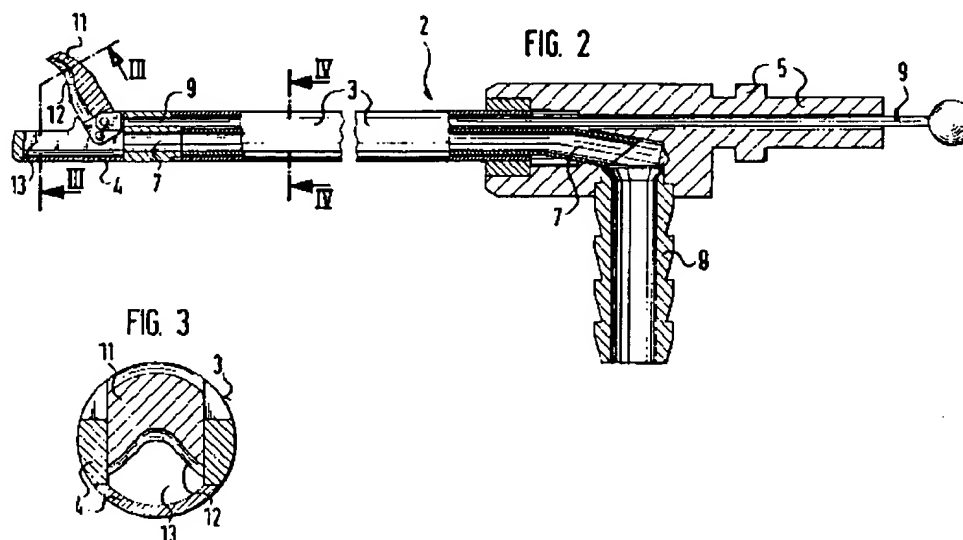
A payment in the amount of \$425 is enclosed. Any deficiency or overpayment should be charged or credited to Hughes Hubbard & Reed Deposit Account No. 08-3264.

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Claim 8

With respect to claim 8, Applicants have added “and a longitudinal axis from said handle portion to said tip portion” after “said bottom shaft piece having a tip portion and a handle portion.” Support for such an addition can be found, for example, in Fig. 3. In addition, Applicants have added “, along said longitudinal axis” after “a top shaft cutting piece slideably engaged.”

The substantive grounds of rejection were with respect to *Falk*, US 4,994,024:



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The Examiner, has taken the position that thrust rod 9 and pivotally attached clipper jaw 11 (shown in Fig. 2 of *Falk*, above) may be considered together as a unit to constitute the “top shaft cutting piece” of claim 8. The Examiner pointed to Fig. 3 of *Falk*, which shows pivotally attached clipper jaw 11 in contact with bottom tip portion (fixed jaw) 4, and inferred therefrom that there is a sliding movement incidental to the closure of clipper jaw 11 against fixed jaw 4.

While Applicants do not concede that the Examiner’s position is correct, it is moot in light of the present amendment, since in no way could a sliding action, as might hypothetically occur in the pivoting closure of the clipper jaw 11 in *Falk* against fixed jaw 4, be characterized as being “along the longitudinal axis” of the bottom shaft (defined as the axis running from handle to tip), as presently claimed. While there appears to be longitudinal sliding of thrust rod 9 in

Falk in the process of actuating clipper jaw 11, that sliding is remote from the tip portion 4 of the bottom shaft piece of the *Falk* reference, contrary to the language of claim 8.

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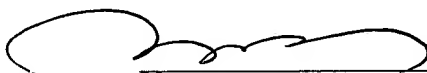
Accordingly, Applicants respectfully request that the rejection of claim 8 be withdrawn in light of the present amendment.

CONCLUSION

Applicants respectfully request that the amendments presented herein be entered, and earnestly solicits allowance of the reissue application based on the foregoing. Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone Applicants' attorney Ronald Abramson, at (212) 837-6404.

Dated: August 18, 2004

Respectfully submitted,



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